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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,966	02/28/2002	Gerald D. Eckstein	8266-0823	3797

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Bose McKinney & Evans LLP
Intellectual Property Group
2700 First Indiana Plaza
135 North Pennsylvania Street
Indianapolis, IN 46204

EXAMINER

KEASEL, ERIC S

ART UNIT PAPER NUMBER

3754

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,966

Applicant(s)

ECKSTEIN ET AL.

Examiner

Eric Keasel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 and 40-54 is/are pending in the application.
- 4a) Of the above claim(s) 45-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 45-54 are directed to inventions of Group I or III. Group II claims were elected without traverse in Paper No. 6. Accordingly, claims 45-54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21, 25-26, and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Brudnicki et al. (US Patent Number 5,529,281).

Brudnicki et al. disclose a valve assembly with a manifold (12) having an inlet, outlet, and a conduit (14), a valve (40) to inhibit or permit flow between the inlet and outlet, a lever (56) pivotally connected to the manifold and located entirely outside the conduit, and a solenoid (44, 30) positioned between the manifold and lever and directly connected to the valve for movement independent of the lever.

“[F]or a hospital bed”, “connected to a device for positioning the bed”, “for a support device”, “configured to connect to a device” are intended use recitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

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art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brudnicki et al.

Brudnicki et al. disclose a valve stem (58) with an opening for the lever rather than the lever having an opening for the valve stem. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the

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art to have located the opening of Brudnicki et al. on the lever rather the valve stem and had the valve stem received in the opening because applicant has not disclosed that the location of the opening and which part is received into which other part provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the arrangement of Brudnicki et al. or the arrangement as set forth in claim 27 because the lever is attached to the valve stem, and also the valve itself, in either arrangement and the functions of both arrangements are the same. Therefore, it would have been an obvious matter of design choice to modify Brudnicki et al. to obtain the invention as specified in claim 27.

6. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brudnicki et al. as applied to claim 21 above, and further in view of McNabb (US Patent Number 5,487,493).

Brudnicki et al. fail to disclose the lock engaging the lever as a lock bar and a lock solenoid. McNabb discloses lock bar (29) and a lock solenoid (24) moving the lock bar to engage a lever (20) in a similar manual operated valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the lock bar and lock solenoid of McNabb in the valve assembly of Brudnicki et al. in order to secure the lever in position as taught by McNabb. Note, McNabb discloses locking the lever in the closed position. It is considered within the ordinary skill of the art to lock the lever in the open position as well.

Response to Arguments

7. Applicant's arguments with respect to claims 21 and 40 have been considered but are not found persuasive.

Re claims 21 and 40, applicant argues that the solenoid moving the valve "independent of the lever" should be read broad enough to encompass applicant's invention; but narrow enough so that Brudnicki et al. does not meet the limitation. In both inventions the valves can be moved by the force generated by the solenoid actuator only or, independently, by the force generated by manually applying a force on the lever actuator. Therefore, Brudnicki et al. anticipates the broadest reasonable interpretation of the claim limitation. There is a fixed, direct coupling between the lever and valve of Brudnicki et al.; whereas applicant's invention has a lost-motion coupling. However, this difference can not be read into the word "independent". It should also be noted that applicant's claims include "a solenoid connected directly to the valve". Similarly, this has been given the broadest reasonable interpretation because applicant's solenoid is only connected to the valve through additional elements.

Re Brudnicki in view of McNabb, applicant argues that since Brudnicki provides for permanent magnets, which hold the valve when a force up to 14 pounds is applied, no one would be motivated to combine a lock solenoid, which does indeed lock the lever. The examiner disagrees. A very modest holding force due to magnets of 14 pounds does not render a true lock obsolete. For example, if it requires 14 pounds of force to open a refrigerator door, is that considered locked? Of course not. If one wanted to lock a refrigerator door that could be opened with only 14 pounds of force, one would be motivated to add a lock. McNabb explicitly

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teaches the lock including a lock bar and lock solenoid with the motivation to lock a lever actuator.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

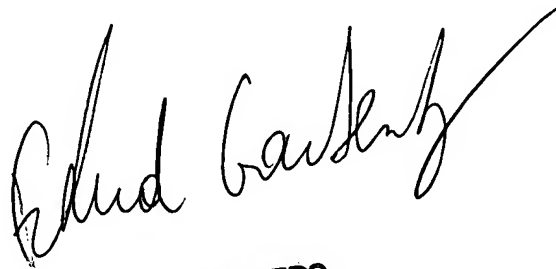
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, or acting supervisor Ehud Gartenberg, can be reached on (703) 308-2696. The fax phone numbers for the organization where this application or proceeding is

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assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

EK5MAR03
ek
March 5, 2003

A handwritten signature in black ink, appearing to read "Ehud Gartenberg", with a long, sweeping horizontal stroke extending to the right.

**EHUD GARTENBERG
PRIMARY EXAMINER**